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09/722,050	11/27/2000	Joseph G. Gatto	089070-0311365	4426
909 7590 04/03/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER SUBRAMANIAN, NARAYANSWAMY				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/722,050

**Applicant(s)**

GATTO, JOSEPH G.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to applicants' communication filed on January 8, 2008. Amendments to claim 1 have been entered. Claims 1-38 are currently pending and have been examined. The rejections and response to arguments are stated below.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-38 are rejected because the claimed invention is directed to non-statutory subject matter.

Claims 1-38, the disclosed invention is inoperative and therefore lacks utility.

Claims 1-38 merely recite elements of an apparatus or a system ("means for" is broadly interpreted to correspond to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. A memory for storing performance data does not show the ability to realize functionality of the recited elements. The display device in the claim has not been positively recited and claimed as a part of the system.

Similarly the claimed modules are interpreted as software. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor).

Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754, where the rejection of a claim to a disembodied data structure

was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, because they are drawn to a system with single means. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Claims 1-38 are drawn to a system comprising a memory with one or more software. The display device in the claim has not been positively recited and claimed as a part of the system. Claims 1-38 are in essence drawn to a system with single means. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 1 recites “the selected contributors selected from among the one or more contributors”. However it is not clear how this selection is achieved. The means for selecting contributors is missing in the claim. Similarly the source of “one or more user-defined criteria” is not clear. If the user is defining the criteria by interacting with the system (as asserted by the Applicants on page 12 of the response), the means for defining the criteria is missing. Similarly the claim recites “earnings estimates performance data for one or more contributors”. However the source of “earnings estimates data for one or more contributors” is missing in the claimed system. Appropriate correction/clarification is required.

Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites “determining earnings estimates performance data for one or more contributors”. However the source of “earnings estimates data for one or more contributors” is not clear. Similarly the source or means for “selecting contributors” and the source or means for “user-defined criteria” are not clear. With these ambiguities the scope of the claim is not clear. Similar ambiguities are present in other dependent claims such as claims 5, 9, 12 and 13 to name a few. Applicants are respectfully requested to correct such ambiguities in their reply to this office action.

Claim 7 recites “one or more of a ticker” and “a unique ticker”. It is not clear if “one or more of a ticker” includes the unique ticker. In this claim the abbreviation “CUSIP” is not clear.

Claim 18 recites “selected time frame”. It is not clear if this the same as “selected fiscal period or selected fiscal periods” recited in claim 16.

Claim 22 recites “at least one historical time-series display”. It is not clear what is being displayed. Similarly claims 23-24 recite “contributor’s estimates and consensus estimates”. It is not clear as to what these estimates are. Similar ambiguities are present in other dependent claims.

Claim 25 recites “with a height indicating the actual reported earnings, on the time axis corresponding to the day the earnings were reported”. It is not clear as to what is it the height of. Also the limitation “the time axis” lacks antecedent basis.

Claim 33 recites “system of claim 27, wherein each contributors’ estimate is represented by a line, further comprising means for ensuring that both lines are visible even if the value over a particular time is the same”. It is not clear what the Applicant means by this limitation.

Claim 38 recites “type of periods”. It is not clear what the Applicant means by this limitation. This claim also recites the limitation “wherein the user-defined criteria includes at least the number and type of periods and a time period over which to determine the earnings estimates performance data”. It is not clear what the Applicant means by this limitation because the user-defined criteria in claim 1 is for aggregating the determined earnings estimates performance data and not for determining the earnings estimates performance data.

Applicants are respectfully requested to review such ambiguities in other claims and correct them in their reply to this office action.

Claims 3-5, 19, 26-27, 32 and 33 recite the steps of a method while claiming a system. Claims 3-5, 19, 26-27, 32 and 33 are not sufficiently precise due to the combining of two

different statutory classes of invention in a single claim. The preamble these claims refer to a system, but the body of the claim discusses the specifics of a method. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991). Appropriate clarification/correction is required.

***Response to Arguments***

8. Amending the independent claim 1 to recite storing the determined earnings estimates performance data in a memory does not overcome the operability requirement under 35 USC 101. The claimed invention is interpreted as a collection of software elements and a memory. The display device in the claim has not been positively recited and claimed as a part of the system. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims disclose operability and the corresponding utility. The Applicants argue that "independent claim 1 expressly recites various hardware components tangibly embodying the useful and concrete results recited therein", however with the exception of a memory there are no other hardware elements claimed as a part of the system. As discussed in the rejection above the "means for" and "software modules" are broadly interpreted to correspond to software program elements and not tangible hardware components. If this interpretation is not correct, the Applicant is respectfully requested to point out where in the specification the "means for" and "software modules" correspond to hardware components only. If these elements are described in the specification to correspond to hardware, software and/or both, the office has the prerogative to interpret these elements broadly as corresponding to software elements alone.

In response to applicant's argument that the Examiner fails to consider certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., independent claim 1 expressly provides that users interact with the system for at least the reason that "user-defined criteria" informs the manner by which "earnings estimates performance data" is aggregated for viewing "via a GUI displayed on a display device") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument "Thus, the feature of independent claim 1 reciting that "the selected contributors [are] selected from among the one or more contributors" specifies how the selection occurs with sufficient precision to satisfy the statutory notice requirement of 35 U.S.C. § 112, second paragraph", the Examiner respectfully disagrees. Without specifying the means used to make the selection, the scope of the system claim is unclear. The Examiner would like to respectfully remind the Applicant that the claim is for a system and not for a method.

Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO



MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/  
Primary Examiner  
Art Unit 3691

March 30, 2008